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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,176	10/23/2000	Christopher J. Warren	1012-065D1	9544

7590

04/22/2003

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EXAMINER

LEADER, WILLIAM T

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 04/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,176

Applicant(s)

WARREN ET AL.

Examiner

William T. Leader

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to a method of fabricating electrode arrays, classified in class 430, subclass 312.
 - II. Claims 10-18, drawn to an electrode array, classified in class 204, subclass 209.01.
 - III. Claims 19-24, drawn to a method depositing materials on electrode arrays, classified in class 205, subclass 136.
 - IV. Claims 25-29, drawn to apparatus for depositing on an electrode array, classified in class 204, subclass 224R.
 - V. Claims 30-34, drawn to a system for electrochemically screening an array, classified in class 204, subclass 400.
 - VI. Claims 35-37, drawn to a method of testing a material in an electrochemical cell, classified in class 205, subclass 775.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the

process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process of the Group I claims can be used to make a materially different product. For example, the process could be used to deposit metal in the form of letters to make a sign on a plastic base.

4. Inventions III and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of the Group IV claims can be used to practice a process materially different than that recited in the Group III claims. For example, the apparatus could be used to deposit materials in a decorative pattern on a single electrode substrate.

5. Inventions V and VI are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of the Group V claims may be used to practice processes materially different from the process of the Group VI claims. For example, rather than placing the array in an electrochemical cell as in

the Group VI process, the apparatus could be used to perform a process in which a localized electrochemical cell is formed adjacent to each addressable electrode on the array being screened.

6. The methods of inventions I, III and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different functions. The claims of Group I are directed to a method fabricating an electrode array, while the claims of Group III are directed to a method depositing materials onto an electrode array. The method fabricating is not related to the method of depositing. The method of depositing can be carried out on electrode arrays fabricated by processes other than that of the Group I claims, and the method of fabricating can be used to make electrode arrays used in deposition processes other than that of the Group III claims. For example, the deposition process of the Group III claims could be carried out on arrays made by individually laminating preformed circuit traces onto a substrate. The claims of Group VI are directed to a method of testing a material in an electrochemical cell and are not related to the method of fabricating of the Group I claims or the method of depositing of the Group III claims. The method testing can be carried out on

electrode arrays fabricated by processes other than that of the Group I claims and on materials deposited by methods other than that of the Group III claims.

7. The apparatus of inventions II, IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different functions. The claims of Group II are directed to an electrode array with a particular configuration, while the claims of Group IV are directed to deposition apparatus. The particular electrode array is not related to the deposition apparatus. The deposition apparatus can be used to deposit materials onto substrates other than the particular electrode array of the Group II claims, and materials can be deposited onto the particular electrode array by deposition apparatus other than that of the Group IV claims. For example, as indicated above, the deposition apparatus could be used to deposit materials in a decorative pattern on a single electrode substrate. The claims of Group V are directed to apparatus for electrochemically screening an array and are not related to the electrode array of the Group II claims or the deposition apparatus of the Group IV claims. The structure of the apparatus for electrochemical screening as claimed does not depend on the structure of the particular electrode array of the

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Group II claims or on the structure of the deposition apparatus of the Group IV claims.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William T. Leader whose telephone number is 703-308-2530. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on 703-308-1146. The fax phone

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numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

WL

William Leader
April 16, 2003

ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700